EXCLUSION OF PRIOR ART UNDER
35 U.S.C. § 103(c) (CREATE Act)
Examining Group 1617
Patent Application
Docket No. MET.037CXT
Serial No. 09/900,364

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner	:	Yong Soo Chong
Art Unit	:	1617
Applicants	:	Paul D. van Poelje, Mark D. Erion, Toshihiko Fujiwara
Serial No.	:	09/900,364
Filed	:	July 5, 2001
Conf. No.	:	7049
For	:	Combination of FBPase Inhibitors and Antidiabetic Agents Useful for the Treatment of Diabetes

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

EXCLUSION OF PRIOR ART UNDER 35 U.S.C. § 103(c)

(CREATE Act)

U.S. Patent Nos. 6,756,360 (Erion *et al.*) and 6,965,033 (Jiang *et al.*) are prior art that is only available under 35 U.S.C. 102(e) and have been used in the formulation of a rejection under 35 U.S.C. § 103(a) in the above-referenced patent application.

As set forth in 35 U.S.C. § 103(c),

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

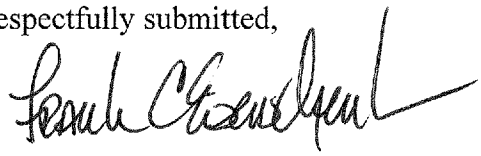
(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

It is respectfully submitted that the presently claimed invention was made by or on behalf of parties to a joint research agreement (within the meaning of 35 U.S.C. 103(c)(3)) that was in effect on or before the date the claimed invention was made; that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and that this application for patent for the claimed invention has been amended to disclose the names of the parties to the joint research agreement. Accordingly, it is respectfully submitted that U.S. Patent Nos. 6,756,360 (Erion *et al.*) and 6,965,033 (Jiang *et al.*) are not available as prior art.

The undersigned invites the Examiner to contact him if clarification is needed or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

The processing fee of $130 was paid at the time this paper was filed. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Respectfully submitted,



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